

04-15-05

EXPRESS MAIL NO.: EV 346 792 953 US

DPW



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re-application of: Andrew DOWNIE et al.

Confirmation No.: 6184

Application No.: 10/798,201

Group Art Unit: 3672

Filing Date: March 10, 2004

Examiner: Andrea M. Valenti

For: DOWNHOLE TOOL

Attorney Docket No.: 85170-4599

**PETITION FOR RETROACTIVE FOREIGN FILING LICENSE  
UNDER 37 C.F.R. § 5.25 and § 5.13**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This petition is responsive to the Communication from the Examiner dated February 11, 2005 in the above identified application. Applicants initial petition for a retroactive foreign filing license filed on August 20, 2004 was denied. Thus, applicants again request a retroactive foreign filing license for U.K. Application No. GB 0101014.9, filed January 15, 2001 in the United Kingdom; and PCT Application No. PCT/GB02/00178, filed January 15, 2002 and designating all Contracting States bound by the Patent Cooperation Treaty. Both applications were entitled "IMPROVED DOWNHOLE TOOL."

The U.K. Application No. GB 0101014.9 was filed in the name of applicant Neyrfor-Weir Limited, and the PCT Application No. PCT/GB02/00178 named one U.S. resident, **Roy POWELL**, residing at 269 Solomon Drive, Estates Park, CO 85017, as an inventor.

The U.S. application corresponding to the U.K. and PCT applications is U.S. Application No. 10/798,201, filed March 10, 2004 and entitled "DOWNHOLE TOOL." Named as inventors in this U.S. Application are: Andrew McPherson DOWNIE; Edward Docherty SCOTT; and Roy POWELL.

Also submitted herewith is a verified statement (declaration) of Dr. David Moreland in support of this petition, prepared in accordance with 37 C.F.R. § 5.25(a)(3).

The fee for this petition is believed to be \$130. Please charge the required fees to Winston & Strawn LLP Deposit Account No. 50-1814.

Respectfully submitted,

Allan A. Fanucci,

Reg. No. 30,256

April 11, 2005

Date

**WINSTON & STRAWN LLP**  
Customer No. 28765  
(212) 294-3311

04/14/2005 WABDEL1 00000005 501814 10798201

01 FC:1463 200.00 DA



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Andrew DOWNIE et al.

Confirmation No.: 6184

Application No.: 10/798,201

Group Art Unit: 3672

Filing Date: March 10, 2004

Examiner: Andrea M. Valenti

For: DOWNHOLE TOOL

Attorney Docket No.: 85170-4599

**DECLARATION OF DR. DAVID MORELAND IN SUPPORT OF  
PETITION FOR RETROACTIVE LICENSE UNDER 37 C.F.R. § 5.25**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Petitioner, Dr. David Moreland, represents that he is the European Patent Attorney responsible for filing U.K. Application No. GB 0101014.9 (filed January 15, 2001) (the UK application) and PCT Application No. PCT/GB02/00178 (filed January 15, 2002) (the PCT application). Although I am somewhat familiar with U.S. law, I did not realize that a U.S. foreign filing license was needed at the time the UK and PCT applications were filed, and thus these applications were filed without first obtaining a license under 37 C.F.R. § 5.11. This is because the UK application was filed in the name of Neyrfor-Weir Limited without disclosing details of the inventors, either names or addresses. Such are not required upon initial filing of a UK provisional patent application. Therefore, at the time of filing the UK application, I was not aware that any of the inventors were located outwith the UK. It was not until preparing the PCT application that I became aware of the inventors' details in this case. However, as the PCT application claimed priority from the UK application, and was of substantially the same content as the UK application, I was not aware at the PCT filing stage that a licence under 37 C.F.R. § 5.11 would be required.

In early March 2004, I instructed Allan Fanucci, the attorney of record for this case, to file a corresponding U.S. patent application in the U.S. Patent and Trademark Office. Soon after the U.S. Application was filed, Mr. Fanucci wrote to me, noting that one of the inventors had a U.S. residence address and asking me to confirm whether this inventor's contribution to the invention was made in the United States. A copy of his March 24, 2004 letter is attached hereto. This was the first time I realized that such a license might be required for those applications.

Best Available Copy

Best Available Copy

After receipt of Mr. Fanucci's letter, I attempted to ascertain whether or not Roy Powell's contributions to the invention were made in the United States. However, due to the acquisition of rights, including the US application from Neyrfor-Weir Limited by Smith International Limited, and subsequent loss of contact with the inventors, it is now difficult to establish such. It appeared that at least some of his contributions may have been made in the United States, and based on that information, I instructed Mr. Fanucci to proceed with the filing of a retroactive request for a foreign filing license. As noted above, I was not aware of such a requirement at the time that the UK and PCT applications were filed, and I confirm that the U.K. and PCT applications were filed without first obtaining a license under 37 C.F.R. § 5.11 through error and without deceptive intent.

In view of the above remarks, it is also asserted that the submission of the petition for a retroactive foreign filing license under 37 C.F.R. §5.25 was and is being diligently sought after discovery of the error in the proscribed foreign filings.

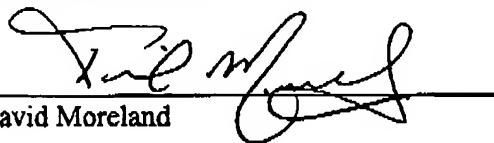
I hereby declare that all statements made herein of my own knowledge, and that all statements made on information and belief, are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date

6<sup>th</sup> April 2005

Dr. David Moreland





## WINSTON & STRAWN LLP

35 WEST WACKER DRIVE  
CHICAGO, ILLINOIS 60601-9703

43 RUE DU RHONE  
1204 GENEVA, SWITZERLAND

CITY POINT  
1 ROPEMAKER STREET  
LONDON, EC2Y 9HT

ALLAN A. FANUCCI  
(212) 294-3311  
afanucci@winston.com

200 PARK AVENUE  
NEW YORK, NEW YORK 10166-4193

(212) 294-6700  
FACSIMILE (212) 294-4700

www.winston.com

38TH FLOOR  
333 SOUTH GRAND AVENUE  
LOS ANGELES, CALIFORNIA 90071-1543

21 AVENUE VICTOR HUGO  
75116 PARIS, FRANCE

101 CALIFORNIA STREET  
SAN FRANCISCO, CALIFORNIA 94111-5894

1400 L STREET, N.W.  
WASHINGTON, D.C. 20005-3502

March 24, 2004

Your Ref. DM/KG/P12003US  
Our Ref.: 85170-4500  
85170-4599

Dr. David Moreland  
CRUIKSHANK & FAIRWEATHER  
19 Royal Exchange Square  
Glasgow G1 3AE  
Scotland, United Kingdom

Re: New U.S. Continuation Patent Appln of Andrew McPherson DOWNIE et al.,  
Application Serial No. 10/798,201; Filed March 10, 2004  
(corresponding to Application No. 10/619,402, Filed: July 14, 2003)  
For: IMPROVED DOWNHOLE TOOL

Dear David:

As we discussed, we have prepared and filed a Continuation application with the U.S. Patent and Trademark Office on March 10, 2004 for the above-referenced invention. A copy of the application and our filing papers are enclosed for your file.

We also simultaneously filed a Petition For Extension of Time together with a Response to Missing Parts and Payment of Retention Fee for the corresponding parent case and a copy is enclosed herewith.

Please note that we received the fax copy of the declaration signed by the first inventor Downie and will submit this upon receipt of the missing parts notice relating to the Continuation application from the U.S. Patent Office. Also, we note that one of the inventors resides in the United States. If his contribution to the invention was made in the U.S., a foreign filing license may have been required prior to the filing of the British priority or PCT applications. If this has not been done, please let us know and we will check on this. If one is needed, we can petition to obtain one retroactively.

In addition, please send us a certified copy of the priority document GB 0101014.9 at your earliest convenience for filing the U.S. Patent and Trademark Office.

## WINSTON & STRAWN LLP

Dr. David Moreland  
March 24, 2004  
Page 2

Finally, we remind you that all U.S. patent applicants, including the inventors and their assigns and attorneys, have a continuing obligation to disclose to the Examiner all prior art references of which they are aware which may be material to patentability of the claims. Material references include any U.S. patents or printed publications (including foreign patents) which disclose the claimed subject matter and which have an effective date which is earlier than the filing date of this application. The effective date of a U.S. patent as a prior art reference is its filing date, while for other documents, it is the publication date. Please advise whether any additional material references exist which should be submitted to the Examiner.

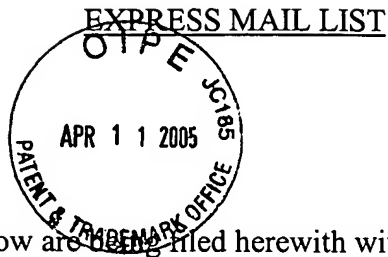
Should you have any questions regarding this matter, please let us know.

Very truly yours,

  
Allan A. Fanucci

Enclosures

To:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



The following items listed below are being filed herewith with the USPTO on April 11, 2005.

Express Mail No. <b>EV 346 792 953 US</b>			
Attorney Docket No.	Appln. Serial No./ Patent No.	Items - Documents filed on <u>April 11, 2005</u>	Patent Fees- Acct. #50-1814
85170-4599	10/798,201	Petition for Retroactive Foreign Filing License (1 page); Declaration of Dr. David Moreland (2 pages); Copy of March 24, 2004 letter (2 pages)	\$130.00
81394-1600	10/832,938	Express Abandonment	\$0
89976-2099	10/328,779	Amendment (8 pages); Submission of Priority Document; German Patent Application No. 10120717.4	\$0
88265-7326	10/268,777	Amendment Fee Transmittal; Amendment (6 pages)	\$250.00

*Please acknowledge receipt of these items as received by returning the enclosed postcards with the date of receipt of April 11, 2005.*

NY:943530.1